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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,141

Applicant(s)

SMITS, HAN

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed April 13, 2005 is acknowledged. Accordingly, claims 1-61 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1); MPEP §608.01(o), and MPEP §2181.

Correction of the following is required:

- a. The "means for facilitating selection of said fuel dispenser options" as recited in claims 1 and 21;
- b. The "means for displaying" as recited in claims 1 and 21;
- c. The "means for saving data" as recited in claim 1;
- d. The "means for transferring" as recited in claims 1 and 21; and
- e. The "means for selecting" as recited in claim 21.

Claim Rejections - 35 USC §112 2nd Paragraph

5. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-61 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with these errors. Some examples follow:

- a. If Applicant desires to invoke 35 U.S.C. §112, 6th paragraph, Applicant has failed to clearly link and associate some corresponding structure to the “means for displaying” as recited in claims 1 and 21.
- b. If Applicant desires to invoke 35 U.S.C. §112, 6th paragraph, Applicant has failed to clearly link and associate some corresponding structure to the “means for facilitating selection of said fuel dispenses options” as recited in claims 1 and 21.
- c. If Applicant desires to invoke 35 U.S.C. §112, 6th paragraph, Applicant has failed to clearly link and associate some corresponding structure to the “means for transferring” as recited in claim 1.
- d. If Applicant desires to invoke 35 U.S.C. §112, 6th paragraph, Applicant has failed to clearly link and associate some corresponding structure to the “means for selecting” as recited in claim 21.
- e. In claim 41, it is unclear if the “saving data” in line 6 is design data (from the fuel dispenser design) or some other type of data. Moreover, the phrase “saving data with said computer comprising said custom fuel dispenser design” does not make grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

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7. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §103

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-61, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Eyon et. al. (U.S. 6,714,937 B1)(“Eyon”) in view of Atchley et. al. (U.S. 5,602,745)(“Atchley”). Eyon discloses a detailed system to customize a product. Eyon does not directly disclose customizing fuel dispenser.

10. Atchley discloses customizing a fuel pump in the design phase. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Eyon as taught by Atchley to include customizing a fuel pump. Such a modification would have allowed the supplier to more easily respond to the desired types of fuel pumps required by various fuels in different locations.

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11. It is the Examiner's factual determination that "transferring data with said computer . . . to a location" as recited in claim 41 is old and well known in the art. For example, the transfer of data may be done via a 'copy' command for back-up purposes or to copy the data to a more transportable drive such as a floppy drive, tape drive, (e.g. zip drive), or other portable drive. See Gavron pages 40 and 41 and How Computers Work pages 12-13 for components within a personal computer ("PC").

12. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,¹ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements² with the required clarity, deliberateness, and precision.³ Third, after receiving express notice in the previous Office Action of the Examiner's

¹ See the Second Non Final Office Action mailed December 9, 2004 , Paragraph No. 10.

² "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

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position that lexicography is not invoked,⁴ Applicant has not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R.

§1.111(b) (*i.e.* Applicant has not argued lexicography *is* invoked). Finally and to be sure of Applicant’s intent, the Examiner also notes that Applicant has declined the Examiner’s express invitation⁵ to be his own lexicographer.⁶ It remains the Examiner’s position that these requirements were reasonable.⁷ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and except for the application of 35 U.S.C. §112 6th paragraph), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed.

⁴ See again the Second Non Final Office Action mailed December 9, 2004 , Paragraph No. 10.

⁵ Id.

⁶ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants’ failure to correct the examiner’s characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner’s express invitation to correct a possible error in claim interpretation: “applicant’s attention was called to the examiner’s interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner’s interpretation—an invitation the applicant did not accept.”).

⁷ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed July 10, 2005).

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Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

13. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹⁰) during ex parte examination.

14. It is the Examiner's position that Applicant has not recited any product-by-process limitations.¹¹

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

¹⁰ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

¹¹ See the Second Non Final Office Action mailed December 9, 2004 , Paragraph No. 12.

Response to Arguments

15. Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive.

16. Regarding the objections to the specification, Applicant argues that "the specification provides clear and full support and antecedent basis for the claim limitations" and directs the Examiner to various points in the specification. This is not found persuasive since Applicant alleges only general areas of the specification. The Examiner highly recommends Applicant review the MPEP sections noted above with particular emphasis on MPEP §2181.

17. Applicant's arguments with respect to 35 U.S.C. §112 2nd paragraph have been considered but are not persuasive. Applicant is reminded that:

A structure disclosed in the specification qualifies as "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing §112, ¶ 6. Fulfillment of the §112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure. *Default Proof Credit Card System Inc. v. Home Depot U.S.A. Inc.*, 75 USPQ2d 1116, 1121 (Fed. Cir. 2005)(citations and quotations omitted)(emphasis in original).

18. Regarding the prior art rejections, Applicant asserts that the "the Examiner has provided no suggestion or motivation drawn from either cited reference to make and sustain the proposed modification."¹² Whether or not this statement is true is immaterial since the motivation need not come expressly from the two references used in the rejection.

¹² Applicant's arguments, page 4, ~ lines 4-5.

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19. Applicant argues that the Examiner's motivation "is not found in Eynon or Atchley."

Again, the motivation to combine need not be found in the two references. So even if

Applicant's point were true, it is not conclusive of the Examiner's determination of obviousness.

20. Applicant also makes comments on page 7 of his remarks and states that "[t]he Examiner has set forth no statutory or administrative authority under the applicable section of Title 35 of the United States Code or Title 37 of the Code of Federal regulations as to the basis for requiring a reply to the noted paragraphs." The Examiner disagrees.

21. First, a careful review of the previous Office Action and this Office Action will reveal that the Examiner has provided Applicant with express notice of at least one applicable authority—37 C.F.R. §1.111(b).¹³ For this reason alone, Applicant's argument that the Examiner has not provided an authority are not persuasive. For guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see *e.g.*: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in his or her next response by stating *why* the Examiner's position regarding the restriction is *substantively* incorrect in order to preserve his or her right to petition¹⁴; MPEP §2144.03 (*i.e.* Official Notice) citing §1.111(b) and noting that traversing the official noticed statement must be made in applicant's *next response*. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well know statement *in the next reply* after the Office action in which the well known statement is made. [Emphasis added.]" Failure to

¹³ Incidentally, the Examiner notes that Applicant's quote of 37 C.F.R. §1.111(b) on page 8 of his remarks (filed April 13, 2004) omits the very language of §1.111(b) on which the Examiner relies. Therefore arguments regarding lack of notice by Applicant would ultimately be unsuccessful.

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seasonable challenge the official noticed statement (*i.e.* in the next response) means that the statement is interpreted as admitted prior art.; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b) and that applicant is required to point out *any* supposed errors in the office action in his or her next response.

22. Second, where Applicant is non-responsive to an issue (*i.e.* silent), the Examiner relies on *Ex parte Knapton*, 67 USPQ2d 1062, 1063 (B.P.A.I. 2002) (unpublished) for the axiom that “silence implies assent” Applicant’s arguments on this matter have therefore been considered but are not persuasive.

Conclusion

23. Applicant’s amendment filed April 13, 2005 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

¹⁴ 37 C.F.R. §1.111(b)’s use in restriction practice is direct evidence of §1.111(b)’s use in procedural requirements (*i.e.* restrictions).

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

Unless expressly noted otherwise by the Examiner using appropriate designations on form PTO-892 (*e.g.* page numbers, chapter selections, or other indicia), all references listed on form PTO-892 are cited in their entirety.

25. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

27. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal

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requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

28. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller’s Desktop Encyclopedia of the Internet, (“Desktop Encyclopedia”) is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller’s Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference’s basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

29. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding

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claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 2) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁵ the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner’s positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
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AJF
July 10, 2005

¹⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.